

Attorney Docket No. P11148

REMARKS/ARGUMENTS**1.) Claim Amendments**

The Applicant has amended claims 1, 4-8, 10, 12-20 and claims 21 to 28 have been canceled without prejudice. Accordingly, claims 1-20 are pending in the application. Favorable reconsideration of the application is respectfully requested in view of the foregoing amendments and the following remarks.

2.) Examiner Objections - Claims

The Examiner objected to claim 20 because of informalities. The Applicant appreciates the Examiner's thorough review of the claims. In order to focus the issues and to expedite allowance of this application, the Applicant has canceled claim 20 without prejudice. Therefore, this rejection is deemed to be moot.

3.) Claim Rejections – 35 U.S.C. § 112

The Examiner rejected claims 4-7 and 12 under the second paragraph of 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which application regards as the invention. The Applicant has amended claims 4-7 and 12 as suggested by the Examiner. The Examiner's consideration of the amended claims is respectfully requested.

4.) Claim Rejections – 35 U.S.C. § 102(a)

The Examiner rejected claims 1-7, 13-14 and 17-28 under 35 U.S.C. § 102(a) as being anticipated by Ericsson (WO 99/16266). In order to expedite allowance of this application, the Applicant has canceled claims 21-28 without prejudice. So, this rejection related to these claims is deemed to be moot. Additionally, the Applicant has amended claims 1, 13-14, and 17-20 to better define the intended scope of the claimed invention. The Examiner's consideration of the amended claims is respectfully requested.

Specifically, the Applicant has modified these claims to include the steps of: checking the allowability of the service parameters; if the service parameters are not

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allowable, negotiating allowable service parameters. It is respectfully submitted that these claims are not found in Ericsson. Because the amended claims contain elements which are not found in Ericsson, a §102 rejection is not proper and should be withdrawn.

Claims 2-7 and 19 depend from the amended independent claims and recite further limitations in combination with the novel elements of these claims. Therefore, the allowance of claims 2-7 and 19 is respectfully also requested.

5.) Claim Rejections – 35 U.S.C. § 103 (a)

The Examiner rejected claims 8-12, 15-16 under 35 U.S.C. § 103(a) as being unpatentable over Ericsson in view of Blake, et al. ("An Architecture for Differentiated Services). The Applicant respectfully traverses this rejection.

First, the Applicant is somewhat confused by the form of the Examiner's rejection. The Examiner apparently is attempting to follow the four steps in MPEP 706.02(j) but does not provide the Applicant with guidance on which claim element can be found in the cited references. For instance, the Examiner states: "As to claim 8, for step (a) Ericsson discloses using a DiffServ." However, claim 8 "using a DiffServ" is not an element nor limitation of claim 8.

The Examiner goes on to state: "For step (b), Ericsson is silent or deficient to the further limitation said differentiation filed (DS) is a Traffic Class Octet according to IPv6 or a Type of service filed according to IPv4." The Applicant does not dispute this statement, but the quoted limitation is again not an element of claim 8.

Claim 8 states:

8. A service parameter interworking method adapted to achieve a service parameter exchange between a network using a circuit-oriented protocol and a network using a packet-oriented protocol, comprising the steps:

receiving circuit-switched service parameters from the network using the circuit-oriented protocol or packet-switched service parameters from the network using the packet-oriented protocol at an interworking node;

mapping said circuit-switched service parameters into corresponding packet-switched parameters or vice versa in said interworking node; and

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forwarding payload data between the different networks using a mapping result; wherein

 said circuit-switched service parameters define a circuit-switched transmission of data and a circuit-switched signalling,

 said packet-switched service parameters define a packet-switched transmission of data and a packet-switched signalling, and

 said circuit-switched service parameters are mapped to said packet-switched service parameters for service differentiation in the network using the packet-oriented protocol through bit settings in a service differentiation field (DS) of data packets.

It is not at all clear to the Applicant which of the above element steps the Examiner contends are found in Ericsson. The Applicant respectfully reminds the Examiner that MPEP 706.02(j) also states: "It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply." The Applicant is not sure what the issues are with respect to claim 8. The Applicant does not wish to burden the Examiner, but respectfully requests that the Examiner set out which claim elements are found in the cited references and where these claim elements are found. Without such direction from the Examiner, the Applicant can only guess at the Examiner's intentions.

In any event, the Applicant has searched Ericsson and could not find in Ericsson nor in Blake where there is a step of forwarding payload data . . . wherein said circuit-switched service parameters define a circuit-switched transmission of data and a circuit-switched signaling . . . said circuit-switched service parameters are mapped to said packet-switched service parameters for service differentiation in the network using the packet-oriented protocol through bit settings in a service differentiation field (DS) of data packets."

As the Office Action states "Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." It is respectfully submitted that all of the claim limitations of claim 8 are not taught by the combination of Ericsson and Boyle. Specifically, the combination of Ericsson and Boyle do not teach nor imply switched service parameters as defined in claim 8 nor using the service differentiation field to communicate *these* parameters. Thus, the §103 rejection should be withdrawn.

Additionally, the Applicant would like to point out that Blake describes

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This architecture only provides service differentiation in one direction of traffic flow and therefore is asymmetric. Development of a complementary symmetric architecture is a topic of current research but is outside the scope of this document. (Blake, page 3, second paragraph from the bottom).

Thus, it is clear that one skilled in the art would only use Blake for one-way communication, and not an "exchange" as claimed in claim 8.

Thus, since this modification of the Blake reference clearly destroys the purpose or function of the invention disclosed in the patent (i.e., to provide an exchange of information), one of ordinary skill in the art would not have found a reason to make the claimed modification.

Thus, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. '103 should be withdrawn.

Claim 10 is patentable for similar reasons. Specifically, the combination of Ericsson and Boyle do not teach nor imply switched service parameters as defined in claim 10 nor using the service differentiation field to communicate *these* parameters. Furthermore, modifying Ericsson with the one-way architecture of Blake clearly destroys the purpose of the claimed invention.

Claims 9, 11, and 12 are dependent claims which contain limitations in addition to the independent claims. Claims 9, 11, and 12 are patentable for the same reasons as their independent claims.

The Examiner rejected claims 15-16 under 35 U.S.C. § 103(a) as being unpatentable over Ericsson in view of Mikkonen (US 6,587,457) and in view of Blake. In order to expedite allowance of this application, the Applicant has amended claims 15-16 to better define the intended scope of the claimed invention. The Examiner's consideration of the amended claims is respectfully requested.

Specifically, the Applicant has modified these claims to include the steps of: checking the allowability of the service parameters; if the service parameters are not allowable, negotiating allowable service parameters. It is respectfully submitted that these claims are not found in the combination of cited references. Because the

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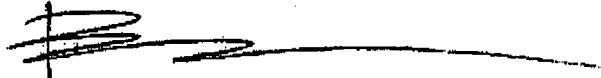
amended claims contain elements which are not found in the combination and the combination must contain *all* the claim elements, a §103 rejection is not proper and should be withdrawn.

CONCLUSION

In view of the foregoing remarks, the Applicant believes all of the claims currently pending in the Application to be in a condition for allowance. The Applicant, therefore, respectfully requests that the Examiner withdraw all rejections and issue a Notice of Allowance for all pending claims.

The Applicant requests a telephonic interview if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,



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